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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,982	01/26/2006	Melchor Daumal Castellon	001058-00031	9466
27557 7590 06/22/2009 BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037				
EXAMINER				
DIAZ, THOMAS C				
ART UNIT		PAPER NUMBER		
3656				
MAIL DATE		DELIVERY MODE		
06/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/565,982

**Applicant(s)**

DAUMAL CASTELLON, MELCHOR

**Examiner**

THOMAS DIAZ

**Art Unit**

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/21/2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/21/2009 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the:

- "said male member has a substantially triangular shape with flat vertexes."  
of claims 8 and 11;
- "said male member has only flat surfaces." Of claims 9 and 12.

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 8, 9, 11, 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

Claims 8 and 11 recite the limitations: "said male member has a substantially triangular shape with flat vertexes." This limitation is not supported by the specification.

In fact, the specification only recites a substantially triangular shape with blunt vertexes. By definition, the word blunt means "rounded" and thus is not flat. Furthermore, the drawings do not clearly show flat vertexes. If you zoom into the vertexes they are rounded. Therefore the claims are not enabled by the specification.

Claims 9 and 12 recite the limitation: "said male member has only flat surfaces." For the same argument presented for claims 8 and 11, the male member has blunt or rounded vertexes and thus does not only compose flat surfaces. There is no support for this limitation in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 8 and 11 recite: "said male member has a substantially triangular shape with flat vertexes." It is unclear what is meant by a substantially triangular shape with flat vertexes. By having these flat sections the shape would no longer be a triangle. Thus it could even be interpreted to be a hexagon. Perhaps, more clearly defining the shape being claimed would clarify the problem.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Runkle (USP 3444753).**

Regarding claim 1, Runkle discloses a similar device comprising:

a female member (fig.1 or 2, 28) adapted for slidingly receiving a male member (fig.1 or 2, 12) therein and at least one metal strip (fig.1 or 2, 22) fitted therebetween having an uneven contact surface (fig.1 or 2, for example 46 is uneven since it is in the form of a wedge. It is noted that various interpretations can be given to the contact surface and that the entire outer surface of the strip can be the contact surface), characterized in that said metal strip is fitted between the male member and the female member and inside at least one recess (fig.1-3, 20) in a fastening cage (fig.1-3, 16; has recesses 20) clamped to the external surface of said male member (fig.1, the cage is clamped to the male member at least by the forces of the metal strips interacting with the female member and by the action of member 34, 36).

Regarding claim 3, Runkle discloses said cage is injected directly on the male member. Regarding the product by process recitations in this claim, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

though the prior product was made by a different process. See MPEP 2113 for more information.

Regarding claim 4, Runkle discloses a plurality of metal strips (fig.1 and 2, 22; there are multiple ones) fitted inside respective recesses (fig.1 and 2, there are multiple recesses) of said cage.

Regarding claim 5, Runkle discloses a similar device comprising a female member (fig.1 and 2, 28) adapted for slidably receiving a male member (fig.1 and 2, 12) therein; at least one metal strip (fig.1 and 2, 22) having an uneven contact surface(fig.1 or 2, for example 46 is uneven since it is in the form of a wedge. It is noted that various interpretations can be given to the contact surface and that the entire outer surface of the strip can be the contact surface); and a fastening cage (fig.1-3, 16) fitted between the male member and the female member, said fastening cage having at least one recess (fig.1-3, 20), said fastening cage surrounding said male member (see fig.3), and said at least one metal strip received in said at least one recess (see fig.1-3).

Regarding claim 6, Runkle discloses a plurality of metal strips (fig.1 and 2, 22; there are multiple ones) fitted inside respective recesses (fig.1 and 2, there are multiple recesses) of said cage.

Regarding claims 7 and 10, Runkle discloses said male member has a substantially polygonal cross-sectional shape (see fig.2).

Regarding claims 8 and 11, Runkle discloses said male member has a substantially triangular shape with flat vertexes (fig.2, as broadly recited a hexagon shown in fig.2 reads on this limitation).

Regarding claims 9 and 12, Runkle said male member has only flat surfaces (see fig. 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Runkle (USP 3444753) in view of Dykema et al. (USP 5417614).**

Regarding claim 2, Runkle fails to disclose said cage is clamped to the outside of the male member by deformations on the lateral surface (of the male member) thereof.

Dykema et al. teaches the use of a deformation on (fig.5, 70) on the lateral surface of a male member (fig.5, 38) for the purpose of clamping a cage (fig.5, 30) to the male member and in order to prevent dislodging of the cage (col.4, lines 16-18).

It would have been obvious to one having ordinary skill at the time of the invention to modify the male member disclosed by Runkle to include a deformation as taught by Dykema et al. for the purpose of providing improved clamping of the cage to the male member and in order to prevent dislodging of the cage (col.4, lines 16-18).



***Response to Arguments***

Applicant's arguments with respect to claims 1, 5 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GB 2349118 A has other forms of uneven contact surfaces which are in the form of protruding members that can further increase the grip of the metal strips and thus improve anti-backlash between a male member and a female member.

Note USP 5152627, 5509324 for shapes of male members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS DIAZ whose telephone number is (571)270-5461. The examiner can normally be reached on Monday-Friday 8:30am to 5:00pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Diaz/  
Examiner, Art Unit 3656

/Richard WL Ridley/  
Supervisory Patent Examiner, Art Unit 3656